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10/616,195

07/08/2003

Michael Zimmerman

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EXAMINER

SALL, EL HADJI MALICK

ART UNIT

PAPER NUMBER

2157

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/616,195 | Applicant(s) ZIMMERMAN ET AL. | |
| | Examiner El Hadji M. Sall | Art Unit 2157 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>07/07/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on July 8, 2003. Claims 1-20 are pending. Claims 1-20 represent turnkey reseller program for registering domain names.

2. ***Specification***

The attempt to incorporate subject matter into this application by reference to U.S. Patent Application Serial Number is ineffective because *the reference document is not clearly identified as required by 37 CFR 1.57(b)(2)*.

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

The disclosure is objected to because it contains an embedded hyperlink on page 2 of the specification. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

3. *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant discloses "a reseller program for allowing a plurality of Customers to register one or more domain names via a

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Registrar...". For the claimed invention to be statutory, it has to be embedded in computer readable medium.

For purpose of prior art rejection, Examiner will construe claim 1-10 as "a reseller program embodied in a machine readable medium for allowing a plurality of Customers to register one or more domain names via a Registrar".

4. Double Patenting

-A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 6 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of copending Application No. 10/616,005. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As to claim 6, Michael teaches the same invention as in claim 6 of copending Application No. 10/616,005.

5. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles U.S. 7,039,697 in view of Vaidyanathan et al. U.S. 20020138291 (referred to hereafter as Vaid).

Vaid teaches the invention substantially as claimed including registry-integrated Internet domain name acquisition system (see abstract).

As to claims 1, 6, 11 and 16, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

A) means for accepting a plurality of Resellers into a reseller program (column 6, lines 26-28);

B) means for creating a registrar web site for registering domain names with an appropriate Registry (figure 2);

C) means for allowing a plurality of Customers to register one or more domain names via the registrar web site, wherein at least one of the plurality of Customers was guided to the registrar web site from actions by one of the plurality of Resellers (column 6, lines 26-28);

D) means for collecting a fee from each Customer that registers a domain name (column 6, lines 32-33).

Bayles fails to teach explicitly E) means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name.

However, Vaid teaches digital file marketplace. Vaid teaches means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name (figure 2; page 2, [0019]).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Bayles in view of Vaid to provide means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name. One would be motivated to do so to allow maintaining the third party website.

As to claims 2, 7, 12 and 17, Bayles teaches the reseller program and the process of claims 1, 6, 11 and 16, wherein the registrar web site has the ability to accept domain names from the Customers, accept information regarding the Customers, check on availability of the domain names, collect a fee from the Customers, register available domain names for the Customers (column 6, lines 26-33; figure 2).

Bayles fails to teach explicitly compensating the plurality of Resellers based on the actions of the Customers.

However, Bail teaches compensating the plurality of Resellers based on the actions of the Customers (figure 2; page 2, [0019]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bayles in view of Vaid to provide compensating the plurality of Resellers based on the actions of the Customers. One would be motivated to do so to allow maintaining the third party website.

As to claims 3 and 14, Bayles teaches the reseller program of claims 1 and 11, wherein the actions by one of the plurality of Resellers include advertisement (column 3,

lines 38-40).

As to claims 4, 9, 13 and 19, Bayles teaches the reseller program and the process of claims 1, 6, 11 and 18, further including means to register domain names via a proxy service, wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name (column 5, lines 32-36).

As to claims 5 and 15, Bayles teaches the reseller program of claim 1, wherein the actions by one of the plurality of Resellers include creating a link to the registrar web site from another web site (figure 1; column 5, lines 37-46).

As to claims 8 and 18, Bayles teaches the reseller program of claims 6 and 14.

Bayles fails to teach explicitly the administration web site offers the option to the resellers to receive electronic payments from the registrar based on activities of the resellers' customers.

However, Vaid teaches the administration web site offers the option to the resellers to receive electronic payments from the registrar based on activities of the resellers' customers (page 2, [0019]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bayles in view of Vaid to provide the administration web site offering the option to the resellers to receive electronic payments from the registrar based on activities of the resellers' customers. One would be motivated to do so to allow

paperless transaction.

As to claims 10 and 20, Bayles teaches the reseller program of claims 6 and 20.

Bayles fails to teach explicitly wherein the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods.

However, Vaid teaches the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods (page 1, [0009]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods. One would be motivated to do so to allow efficient tracking of a reseller commission.

7. *Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art: 20020091827; 20030105868; 20060161681; 20040167982.

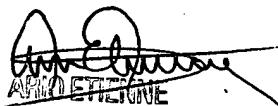
7. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 571-272-4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4010.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall
Patent Examiner
Art Unit: 2157


ARIO ETIENNE
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